



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/655,371	09/04/2003	Susann Marie Keohane	AUS920030641US1	8434
35525	7590	11/05/2008		
IBM CORP (YA) C/O YEE & ASSOCIATES PC P.O. BOX 802333 DALLAS, TX 75380			EXAMINER NAJEE-ULLAH, TARIQ S	
			ART UNIT 2456	PAPER NUMBER
			NOTIFICATION DATE 11/05/2008	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ptonotifs@yeciipaw.com

### Office Action Summary

**Application No.**

10/655,371

**Applicant(s)**

KEOHANE ET AL.

**Examiner**

TARIQ S. NAJEE-ULLAH

**Art Unit**

2456

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Amendment*

1. This Office action has been issued in response to Applicant's Amendment filed August 11, 2008. By action of this amendment, claim 1 has been amended. Claim 1 in pending in this application.

### *Response to Arguments*

2. Applicant's arguments regarding the rejection of claim 1 under 35 U.S.C. 102(b) as being anticipated by US Patent Application Publication 2002/0090069 to Yaker have been considered but are moot in view of the new ground(s) of rejection.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Application Publication 2002/0090069 to Yaker in view of US Patent Application Publication 2004/0243844 to Adkins.

Regarding claim 1, Yaker teaches, **a method for selectively generating automatic notifications that a user is away, the method comprising: responsive to receiving an email message at an email address of the user** (Yaker, pg. 2, par. 25; email tool automatically transmitting the appropriate "out-of-office" message to the third party in response to an incoming email message); **responsive to a determination that**

**the email address of the sender is an email address in the set of determined email addresses, sending an away notification to the email address of the sender**

(Yaker, pg. 2, par. 24-26; Yaker teaches an evaluation process upon receipt of the email as to whether or not an away notification is sent and if so, what information should be sent); **and responsive to a determination that the email address of the sender is not an email address in the list of determined email addresses, not sending an away notification to the email address of the sender** (Yaker, pg. 2, par. 24-26; Yaker teaches an evaluation process upon receipt of the email as to whether or not an away notification is sent and if so, what information should be sent).<sub>2</sub>

While Yaker teaches incoming email messages can be sorted or managed on the basis of a pre-determined criteria, such as source of the email and keywords, i.e. time periods, message fields, etc. that trigger a certain pre-determined response, Yaker does not explicitly teach all limitations regarding **determining whether an e-mail address of the sender of the email message is an email address in a set of determined email addresses comprising email addresses of recipients to which email messages have been previously sent within a configurable time period that is uniquely associated with each email address in the set of determined email addresses, wherein the set of determined email addresses and a date associated with each email address is the set of determined email addresses is stored in a data structure, and wherein the date associated with each email address in the set of determined email addresses is a date an email message was sent to the associated email address from the email address of the user.**

Adkins teaches determining whether an e-mail address of the sender of the email message is an email address in a set of determined email addresses comprising email addresses of recipients to which email messages have been previously sent within a configurable time period that is uniquely associated with each email address in the set of determined email addresses (Adkins, fig. 5, steps 501-513; pg. 7, par. 129-135), wherein the set of determined email addresses and a date associated with each email address is the set of determined email addresses is stored in a data structure (Adkins, fig. 5, steps 501-513; pg. 7, par. 129-135), and wherein the date associated with each email address in the set of determined email addresses is a date an email message was sent to the associated email address from the email address of the user (Adkins, fig. 5, steps 501-513; pg. 7, par. 129-135).

Adkins and Yaker are analogous art because they are from the same field of endeavor of network communication and messaging. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use Adkins method of sorting and determining a specific set of messages with Yaker's method for automatic processing of incoming email messages. The suggestion/motivation would have been to provide an authorized email control system that integrates into an email server architecture as well as a client system (Adkins, pg. 1, par. 11-13).

**Conclusion**

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: US 2003/0020749 to Abu-Hakima et al; US 2002/0188683 to Lytle et al; US 2002/0169841 to Carlson et al; US 6,212,553 to Lee et al.
6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **TARIQ S. NAJEE-ULLAH** whose telephone number is (571)270-5013. The examiner can normally be reached on Monday through Friday 8:30 - 6:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on (571) 272-3913. The fax

phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

T. N.

/Bunjob Jaroenchonwanit/  
Supervisory Patent Examiner, Art Unit 2456